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**PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of  
Gerard Francis Barry  
Ganesh Murthy Kishore

Serial No.: 09/612,404

Filed: July 7, 2000

For: GLYPHOSATE TOLERANT PLANTS

Group Art Unit: 1652

Examiner: \_\_\_\_\_

Atty. Dkt. No.: 11914.0140.NPUS00  
MONY:140/WAA

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

U.S. Patent No. 5,776,760 is the subject of litigation. U.S. Patent No. 5,776,760 was asserted in the Complaint filed in *Monsanto Company v. Pioneer Hi-Bred International, Inc.*, Civil Action No. 99C 1917, in the United States District Court for the Eastern District of Missouri. Copies of the complaint and answer are enclosed.

No fees are believed to be due in connection with the filing of this Notice of Litigation, however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be deemed necessary for any reason

relating to these materials, the Assistant Commissioner is hereby authorized to deduct said fees from Deposit Account No. 01-2508/MONY:140/WAA.

Respectfully submitted,



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Please type a plus sign (+) inside this box →

PTO/SB/21 (08-00)

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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

		Application Number	09/612,404
		Filing Date	07/07/00
		First Named Inventor	Gerard Francis Barry
		Group Art Unit	1652
		Examiner Name	
Total Number of Pages in This Submission		Attorney Docket Number	MONY:140/WAA

### ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input checked="" type="checkbox"/> Information Disclosure Statement (PTO Form 1449, including copies of cited references)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Notice of Litigation Return Receipt Postcard
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Request for Refund	
	<input type="checkbox"/> CD, Number of CD(s) _____	
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PTO: 2001

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or individual name	Janelle D. Waack Howrey Simon Arnold & White, LLP
Signature	<i>Ron Laby for Janelle Waack</i>
Date	January 11, 2001

### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date:

Typed or printed name	Janelle D. Waack, Reg. No. 36,300
Signature	<input type="text"/>
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IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF MISSOURI  
EASTERN DIVISION

Dec 8

FILED

MONSANTO COMPANY,

DEC - 8 1999

Plaintiff,

U. S. DISTRICT COURT  
EASTERN DISTRICT OF MISSOURI  
ST. LOUIS

v.

PIONEER HI-BRED INTERNATIONAL, INC.,

CIVIL ACTION NO. \_\_\_\_\_

Defendant.

4 : 99 C 01917 L 00

JURY TRIAL DEMANDED

COMPLAINT

Plaintiff, Monsanto Company ("Monsanto"), brings this action against Defendant, Pioneer Hi-Bred International, Inc., a wholly-owned subsidiary of E.I. du Pont de Nemours and Company, and alleges as follows:

1. This is an action for breach of contract, patent infringement, and misappropriation of trade secrets.

The Parties

2. Plaintiff Monsanto is a corporation organized and existing under the laws of the State of Delaware and has its principal place of business at 800 North Lindbergh Boulevard, St. Louis, Missouri.

3. Prior to October 1, 1999, a corporation named Pioneer Hi-Bred International, Inc. ("Pioneer") was a corporation organized under the laws of the State of Iowa with its principal place of business located at 700 Capital Square, 400 Locust Street, Des Moines, Iowa. Although bearing

the same name as the defendant in this case, the corporation referenced in this paragraph is not the defendant as Pioneer ceased to exist as of October 1, 1999.

4. On October 1, 1999, Pioneer was merged into Delta Acquisition Sub, Inc. (the "Merger"). On information and belief, the Merger took place through a process whereby E.I. du Pont de Nemours and Company created a wholly-owned subsidiary, Delta Acquisition Sub, Inc., solely for purposes of effectuating the Merger, and then merged Pioneer with and into Delta Acquisition Sub, Inc. The result of the Merger was that Pioneer ceased to exist.

5. Delta Acquisition Sub, Inc., the sole surviving corporation after the Merger, was created by E.I. du Pont de Nemours and Company under the laws of the State of Iowa and has its principal place of business at 700 Capital Square, 400 Locust Street, Des Moines, Iowa.

6. As a part of the Merger, Delta Acquisition Sub, Inc.'s name was changed to Pioneer Hi-Bred International, Inc. and is presently doing business under the name of Pioneer Hi-Bred International, Inc.

7. Delta Acquisition Sub, Inc., now known as Pioneer Hi-Bred International, Inc., a wholly-owned subsidiary of E.I. du Pont de Nemours and Company, is the defendant in this case. Pioneer, referenced in Paragraph 3 above, no longer exists and, therefore, is not the defendant in this action.

8. For purposes of distinguishing between: (a) the pre-merger entity, the entity referenced in Paragraph 3 which no longer exists; and (b) the post-merger entity operating under the same name, but as a wholly-owned subsidiary of E.I. du Pont de Nemours and Company, Monsanto will hereinafter refer to the pre-merger entity as "Pioneer" and the post-merger entity as "du Pont Sub."

### Jurisdiction and Venue

9. Defendant du Pont Sub is an Iowa corporation and is qualified to do, and is doing, business in Missouri and is subject to the jurisdiction of this Court.

10. Subject matter jurisdiction is conferred on this Court by 28 U.S.C. §§ 1331, 1332, 1338(a), 1338(b), and 1367(a). Diversity jurisdiction attaches because the parties are citizens of different states and the amount in controversy exceeds \$75,000. Jurisdiction under 28 U.S.C. § 1338(a) attaches because this case alleges patent infringement. Jurisdiction under 28 U.S.C. § 1338(b) attaches because this case involves a substantial claim of unfair competition (trade secret misappropriation) joined with a substantial and related claim under the patent laws. Jurisdiction under 28 U.S.C. §1367(a) attaches because each of the claims in this action forms part of the same case or controversy under Article III of the United States Constitution.

11. Venue is proper in this Court under 28 U.S.C. §§1391 and 1400(b).

### Background

12. Plaintiff Monsanto is a leader in the development of crops that have been genetically engineered to express new traits of value to the farmer, such as a herbicide resistance. Products developed by Monsanto include soybeans and rapeseed that contain a gene, known as the CP4 gene, that confers resistance to the herbicide glyphosate. Soybeans and rapeseed (canola) containing Monsanto's CP4 glyphosate resistance gene are sold under the trademark Roundup Ready®. Monsanto's Roundup Ready® canola also contains an additional proprietary glyphosate resistance gene of Monsanto called the GOX gene. Roundup Ready® products have been a recognized commercial success. First introduced to the market in 1996, Roundup Ready® soybeans, for example, now account for around half of the soybean acreage planted in the United States.

13. Recognizing the value of Monsanto's glyphosate resistance technology, Pioneer licensed it for use in certain crops, namely soybeans and varietal rapeseed in 1992. On April 22, 1992, Plaintiff Monsanto and Pioneer entered into a License Agreement ("the 1992 License Agreement") relating to such crops. On April 30, 1998, the provisions of the 1992 License Agreement pertaining to varietal rapeseed, except for obligations of confidentiality, were superseded and replaced by a Canola/Rapeseed License Agreement ("the 1998 Canola/Rapeseed License Agreement"). The 1992 License Agreement as pertaining to soybeans remained unchanged.

14. Pursuant to the 1992 License Agreement, Monsanto granted to Pioneer a limited license to certain rights and technology of Monsanto relating to tolerance to the herbicide glyphosate in soybeans.

15. Specifically, Article 3.1 of the 1992 License Agreement provided:

MONSANTO hereby grants to PIONEER and PIONEER's AFFILIATES, and PIONEER and its AFFILIATES hereby accept, on and subject to the terms and conditions of this Agreement, a nonexclusive, nontransferable LICENSE under MONSANTO PATENT RIGHTS and MONSANTO KNOW-HOW to develop, produce, have produced, and to sell LICENSED COMMERCIAL SEED and in THE TERRITORY; provided further that, PIONEER shall be permitted to sell LICENSED COMMERCIAL SEED anywhere in the world upon written notification to MONSANTO of PIONEER's intent to sell in specific countries, and MONSANTO's response within ninety (90) days that it chooses not to add the specified countries to THE TERRITORY if such LICENSED COMMERCIAL SEED sold in countries outside THE TERRITORY is not promoted as being tolerant to GLYPHOSATE (unless required by law) and PIONEER secures all necessary regulatory approvals for the sale of such LICENSED COMMERCIAL SEED in the pertinent country.

16. Article 2.1 of the 1992 License Agreement contained a number of definitions.

MONSANTO PATENT RIGHTS was defined as patents and patent applications listed in Exhibit A to the Agreement, including extensions, continuations, continuations-in-part, reissues or divisions thereof. MONSANTO KNOW-HOW was defined as "any information, biological material or germplasm, and data obtained, produced or made by or for MONSANTO prior to the EFFECTIVE

DATE of this Agreement relating to THE GENE and its expression in LICENSED PLANT SPECIES disclosed to PIONEER by MONSANTO pursuant to this Agreement." The GENE or GENE(S) was defined as "a DNA molecule including regulatory sequences received from MONSANTO by PIONEER or a replicate thereof which when inserted into the LICENSED PLANT SPECIES results in increased tolerance to glyphosate herbicide."

17. Pursuant to Article 3.1, the 1992 License Agreement and the rights granted thereunder were expressly stated to be nontransferable, and pursuant to Article 13.2 "the rights and obligations of [the 1992 License Agreement] are personal to Pioneer" and are expressly stated to be non-assignable except with the written consent of Monsanto.

18. Article 4.1 of the 1992 License Agreement provided that Monsanto would insert "THE GENE" or "GENES" into germplasm to be supplied to Pioneer. Monsanto crossed germplasm from a Monsanto soybean event designated 40-3-2 into Pioneer germplasm and delivered that germplasm to Pioneer. Monsanto also supplied Pioneer with GENE(S) for use by Pioneer as provided by Article 4 of the Agreement.

19. The 1998 Canola/Rapeseed License Agreement extended only to "openly pollinated and hybrid canola/rapeseed varieties of the species *Brassica napus*, *Brassica rapa*, and *Brassica juncea* excluding high stearate canola products." Specifically, Article 3.1 of the 1998 Canola/Rapeseed License Agreement provided:

(a) MONSANTO hereby grants to PIONEER and PIONEER's AFFILIATES, and PIONEER and its AFFILIATES hereby accept, on and subject to the terms and conditions of this CANOLA/RAPESEED AGREEMENT, a nonexclusive, nontransferable LICENSE under MONSANTO PATENT RIGHTS and MONSANTO KNOW-HOW to develop, produce, have produced, and to sell LICENSED COMMERCIAL SEED and in THE TERRITORY;

Subject to the terms of this Agreement, including but not limited to the terms of paragraph 3.1(b), PIONEER shall be permitted to sell LICENSED COMMERCIAL SEED anywhere in the world: (a) upon written notification to MONSANTO of PIONEER's intent to sell in

specific countries, and (b) MONSANTO's response within ninety (90) days that it chooses not to add the specified countries to THE TERRITORY, if such LICENSED COMMERCIAL SEED sold in countries outside THE TERRITORY is not promoted as being tolerant to GLYPHOSATE (unless required by law) and if PIONEER secures all necessary regulatory approvals in consultation with MONSANTO for the sale of such LICENSED COMMERCIAL SEED in the pertinent country. MONSANTO shall disclose to PIONEER, in a timely fashion, relevant information in its possession that it is free to disclose, which may reasonably be required to gain regulatory approval for LICENSED COMMERCIAL SEED under this paragraph.

20. Article 2.1 of the 1998 CANOLA/RAPESEED AGREEMENT contained a number of definitions. MONSANTO PATENT RIGHTS was defined as patents and patent applications listed in Exhibit A to the Agreement, including extensions, continuations, continuations-in-part, reissues or divisions thereof. MONSANTO KNOW-HOW was defined as "any information, biological material or germplasm, and data obtained, produced or made by or for MONSANTO prior to the EFFECTIVE DATE of this CANOLA/RAPESEED AGREEMENT relating to THE GENE and its expression in LICENSED PLANT SPECIES disclosed to PIONEER by MONSANTO pursuant to this CANOLA/RAPESEED AGREEMENT." The GENE or GENE(S) was defined as "a DNA molecule including regulatory sequences received from MONSANTO by PIONEER or a replicate thereof which when inserted into the LICENSED PLANT SPECIES results in increased tolerance to glyphosate herbicide."

21. Pursuant to Article 3.1, the 1998 Canola/Rapeseed Agreement and the rights granted thereunder were expressly stated to be nontransferable, and pursuant to Article 13.2 "the rights and obligations of [the 1998 Canola/Rapeseed License Agreement] are personal to Pioneer" and are expressly stated to be non-assignable except with the written consent of Monsanto.

22. The glyphosate resistance genes (GENES) that reside in the germplasm and in the DNA vectors delivered by Monsanto in connection with the 1992 License Agreement and the 1998

Canola/Rapeseed License Agreement are the CP4 gene (soybean and canola/rapeseed) and the GOX gene (canola/rapeseed).

23. In soybeans, the CP4 gene is driven by a CaMV promoter. In soybeans, the CP4 gene is targeted to the chloroplast by an EPSPS chloroplast transit peptide. In canola/rapeseed, the CP4 and GOX genes are driven by an FMV promoter. In canola/rapeseed, the CP4 gene is targeted to the chloroplast by an EPSPS chloroplast transit peptide. The GOX gene employs a rubisco SSU chloroplast transit peptide.

**Breach and Termination of the 1992 License Agreement**

24. As indicated in paragraph 17 above, the 1992 License Agreement was expressly stated to be personal to Pioneer and nontransferable. By virtue of its merger into Delta Acquisition Sub, Inc., Pioneer and du Pont Sub purported to effect a prohibited transfer of Pioneer's rights under the 1992 License Agreement that was expressly in violation of the terms of the 1992 License Agreement, constituting a material breach of the 1992 License Agreement. Further, the purported transfer was null and void because of the nontransferability of the 1992 License Agreement. Thus, the 1992 License Agreement is terminated, both by operation of law and by material breach. The Trademark License Agreement, which was a part of the 1992 License Agreement, is also deemed terminated by operation of law and by notice according to its terms.

25. Article 5.1 of the 1992 License Agreement specifically acknowledges that "all MONSANTO KNOW-HOW, GENES and MONSANTO PATENT RIGHTS are and shall remain the property of MONSANTO." Further, pursuant to Article 11.2 of the 1992 License Agreement, upon termination of the 1992 Agreement, all MONSANTO KNOW-HOW or other confidential information of Monsanto is to be destroyed or returned to Monsanto.

26. Despite the termination of the 1992 License Agreement and the fact that it has no rights thereunder due to the violation of the nontransferability provision and the nontransferability of the licenses of this type in law, Defendant du Pont Sub has made, used, sold and offered for sale, soybeans containing the Roundup Ready® CP4 gene owned by Monsanto and, on information and belief, intends to continue such making, using, selling, and offering for sale. Such use, sale and offer for sale is without any right or authorization from Monsanto, and furthermore, if done under the Roundup Ready® trademark, will constitute trademark infringement. Pioneer has also transferred to Defendant du Pont Sub the MONSANTO KNOW-HOW and confidential information of Monsanto that Pioneer obtained pursuant to the 1992 License Agreement. Such transfer, and du Pont Sub's possession of such KNOW-HOW and confidential information, is without any right or authorization from Monsanto. Such transfers further constitute a material breach of the 1992 Agreement, not susceptible to cure since Pioneer has ceased to exist.

**Breach and Termination of the 1998 Canola/Rapeseed License Agreement**

27. As indicated in paragraph 21 above, the 1998 Canola/Rapeseed License Agreement was expressly stated to be personal to Pioneer and nontransferable. By virtue of its merger into Delta Acquisition Sub, Inc., Pioneer and du Pont Sub purported to effect a prohibited transfer of Pioneer's rights under the 1998 Canola/Rapeseed License Agreement that was expressly in violation of the terms of the 1998 Canola/Rapeseed License Agreement, constituting a material breach of the 1998 Canola/Rapeseed License Agreement. Further the purported transfer was null and void because of the nontransferability of the 1998 Canola/Rapeseed License Agreement. Thus, the 1998 Canola/Rapeseed License Agreement is terminated, both by operation of law and by material breach. The Trademark License Agreement, which was a part of the 1998

Canola/Rapeseed License Agreement, is also deemed terminated by operation of law and by notice according to its terms.

28. Article 5.1 of the 1998 Canola/Rapeseed License Agreement specifically acknowledges that "all MONSANTO KNOW-HOW, GENE(S) and MONSANTO PATENT RIGHTS are and shall remain the property of MONSANTO." Further, pursuant to Article 11.2 of the 1998 Canola/Rapeseed License Agreement, upon termination of the 1998 Canola/Rapeseed License Agreement, all MONSANTO KNOW-HOW or other confidential information of Monsanto is to be destroyed or returned to Monsanto.

29. Despite the termination of the 1998 Canola/Rapeseed License Agreement and the fact that it has no rights thereunder due to the violation of the nontransferability provision and the nontransferability of the licenses of this type in law, Defendant du Pont Sub has made, used, sold and offered for sale, rapeseed containing the Roundup Ready® CP4 and GOX genes owned by Monsanto and, on information and belief, intends to continue such making, using, selling, and offering for sale. Such use, sale and offer for sale is without any right or authorization from Monsanto, and furthermore if done under the Roundup Ready® trademark will constitute trademark infringement. Pioneer has also transferred to Defendant du Pont Sub the MONSANTO KNOW-HOW and confidential information of Monsanto that Pioneer obtained pursuant to the 1998 Canola/Rapeseed License Agreement. Such transfer, and du Pont Sub's possession of such KNOW-HOW and confidential information, is without any right or authorization from Monsanto. Such transfers further constitute a material breach of the 1998 Canola/Rapeseed Agreement, not susceptible to cure since Pioneer has ceased to exist.

**COUNT I - BREACH OF CONTRACT**

30. Monsanto re-alleges and incorporates by reference each of paragraphs 1-29 above as set forth herein, and further alleges that Monsanto has performed its obligations under the 1992 License Agreement.

31. Through the purported prohibited transfer of the 1992 License Agreement and the prohibited transfer of MONSANTO KNOW-HOW and confidential information to du Pont Sub, a new corporate entity created by E.I. du Pont de Nemours and Company, Defendant has materially breached the 1992 License Agreement. Because Pioneer has ceased to exist, the material breach of the 1992 License Agreement may not be cured.

32. Pursuant to Section 10.3 of the 1992 Agreement, Monsanto hereby gives notice of the termination of the 1992 Agreement and pursuant to Section 11.2 of the 1992 Agreement, demands return or destruction of the GENE and all other tangible forms of "MONSANTO KNOW-HOW or other Confidential Information of MONSANTO" transferred to Pioneer under said 1992 Agreement, including all germplasm containing the CP4 gene, within thirty (30) days of the date of this notice.

33. Defendant's breach of the 1992 License Agreement has materially harmed Monsanto and caused it to incur damages in excess of \$75,000.

34. Monsanto re-alleges and incorporates by reference each of paragraphs 1-33 above as set forth herein, and further alleges that Monsanto has performed its obligations under the 1998 Canola/Rapeseed License Agreement.

35. Through its purported prohibited transfer of the 1998 Canola/Rapeseed License Agreement and the prohibited transfer of MONSANTO KNOW-HOW and confidential information to du Pont Sub, a new corporate entity created by E.I. du Pont de Nemours and

Company, Defendant has materially breached the 1998 Canola/Rapeseed License Agreement. Because Pioneer has ceased to exist, the material breach of the 1998 Canola/Rapeseed License Agreement may not be cured.

36. Pursuant to Section 10.4 of the 1998 Canola/Rapeseed Agreement, Monsanto hereby gives notice of the termination of the 1998 Agreement and pursuant to Section 11.2 of the 1998 Canola/Rapeseed Agreement, demands return or destruction of the GENE and all other tangible forms of "MONSANTO KNOW-HOW or other Confidential Information of MONSANTO" transferred to Pioneer under said 1998 Agreement, including all germplasm containing the CP4 and GOX genes, within thirty (30) days of the date of this notice.

37. Defendant's breach of the 1998 Canola/Rapeseed License Agreement has materially harmed Monsanto and caused it to incur damages in excess of \$75,000.

#### **COUNT II - PATENT INFRINGEMENT**

##### **U.S. Patent No. 5,633,435**

38. Monsanto re-alleges and incorporates by reference each of paragraphs 1-37 above as set forth herein. Technology in the material transferred to Pioneer is covered by United States Patent 5,633,435. A copy of U.S. Patent No. 5,633,435 is attached as Exhibit 1 to this Complaint.

39. Monsanto has been and is the owner of all right, title and interest to and under U.S. Patent No. 5,633,435. U.S. Patent No. 5,633,435 duly and legally issued to Monsanto on May 27, 1997.

40. By virtue of its making, using, selling and offering for sale soybeans and rapeseed containing Monsanto's CP4 gene, Defendant is infringing and is actively inducing others to infringe Monsanto's U.S. Patent No. 5,633,435 and will continue to do so unless enjoined by this court.

41. Defendant's infringement of U.S. Patent No. 5,633,435, upon information and belief, is knowing and willful.

**U.S. Patent No. 4,940,835**

42. Monsanto re-alleges and incorporates by reference each of paragraphs 1-41 above as set forth herein. Technology in the material transferred to Pioneer is also covered by United States Patent 4,940,835. A copy of U.S. Patent No. 4,940,835 is attached as Exhibit 2 to this Complaint.

43. Monsanto has been and is the owner of all right, title and interest to and under U.S. Patent No. 4,940,835. U.S. Patent No. 4,940,835 duly and legally issued to Monsanto on July 10, 1990.

44. By virtue of its making, using, selling and offering for sale soybeans and rapeseed containing Monsanto's CP4 gene, Defendant is infringing and is actively inducing others to infringe Monsanto's U.S. Patent No. 4,940,835 and will continue to do so unless enjoined by this court.

45. Defendant's infringement of U.S. Patent No. 4,940,835, upon information and belief, is knowing and willful.

**U.S. Patent No. 5,188,642**

46. Monsanto re-alleges and incorporates by reference each of paragraphs 1-45 above as set forth herein. Technology in the material transferred to Pioneer is also covered by United States Patent 5,188,642. A copy of U.S. Patent No. 5,188,642 is attached as Exhibit 3 to this Complaint.

47. Monsanto has been and is the owner of all right, title and interest to and under U.S. Patent No. 5,188,642. U.S. Patent No. 5,188,642 duly and legally issued to Monsanto on February 23, 1993.

48. By virtue of its making, using, selling and offering for sale soybeans and rapeseed containing Monsanto's CP4 gene, Defendant is infringing and is actively inducing others to infringe Monsanto's U.S. Patent No. 5,188,642 and will continue to do so unless enjoined by this court.

49. Defendant's infringement of U.S. Patent No. 5,188,642, upon information and belief, is knowing and willful.

**U.S. Patent No. 5,352,605**

50. Monsanto re-alleges and incorporates by reference each of paragraphs 1-49 above as set forth herein. Technology in the material transferred to Pioneer is also covered by United States Patent 5,352,605. A copy of U.S. Patent No. 5,352,605 is attached as Exhibit 4 to this Complaint.

51. Monsanto has been and is the owner of all right, title and interest to and under U.S. Patent No. 5,352,605. U.S. Patent No. 5,352,605 duly and legally issued to Monsanto on October 4, 1994.

52. By virtue of its making, using, selling and offering for sale soybeans containing Monsanto's CP4 gene driven by a CaMV promoter, Defendant is infringing and is actively inducing others to infringe Monsanto's U.S. Patent No. 5,352,605 and will continue to do so unless enjoined by this court.

53. Defendant's infringement of U.S. Patent No. 5,352,605, upon information and belief, is knowing and willful.

**U.S. Patent No. 5,530,196**

54. Monsanto re-alleges and incorporates by reference each of paragraphs 1-53 above as set forth herein. Technology in the material transferred to Pioneer is also covered by United States Patent 5,530,196. A copy of U.S. Patent No. 5,530,196 is attached as Exhibit 5 to this Complaint.

55. Monsanto has been and is the owner of all right, title and interest to and under U.S. Patent No. 5,530,196. U.S. Patent No. 5,530,196 duly and legally issued to Monsanto on June 25, 1996.

56. By virtue of its making, using, selling and offering for sale soybeans containing Monsanto's CP4 gene driven by a CaMV promoter, Defendant Pioneer is infringing and is actively inducing others to infringe Monsanto's U.S. Patent No. 5,530,196 and will continue to do so unless enjoined by this court.

57. Defendant's infringement of U.S. Patent No. 5,530,196, upon information and belief, is knowing and willful.

**U.S. Patent No. 5,776,760**

58. Monsanto re-alleges and incorporates by reference each of paragraphs 1-57 above as set forth herein. Technology in the material transferred to Pioneer is also covered by United States Patent 5,776,760. A copy of U.S. Patent No. 5,776,760 is attached as Exhibit 6 to this Complaint.

59. Monsanto has been and is the owner of all right, title and interest to and under U.S. Patent No. 5,776,760. U.S. Patent No. 5,776,760 duly and legally issued to Monsanto on July 7, 1998.

60. By virtue of its making, using, selling and offering for sale rapeseed containing Monsanto's GOX gene, Defendant is infringing and is actively inducing others to infringe Monsanto's U.S. Patent No. 5,776,760 and will continue to do so unless enjoined by this court.

61. Defendant's infringement of U.S. Patent No. 5,776,760, upon information and belief, is knowing and willful.

**U.S. Patent No. 5,378,619**

62. Monsanto re-alleges and incorporates by reference each of paragraphs 1-61 above as set forth herein. Technology in the material transferred to is also covered by United States Patent 5,378,619. A copy of U.S. Patent No. 5,378,619 is attached as Exhibit 7 to this Complaint.

63. Monsanto has been and is the owner of all right, title and interest to and under U.S. Patent No. 5,378,619. U.S. Patent No. 5,378,619 duly and legally issued to Monsanto on January 3, 1995.

64. By virtue of its making, using, selling and offering for sale rapeseed containing Monsanto's GOX gene driven by an FMV promoter, Defendant is infringing and is actively inducing others to infringe Monsanto's U.S. Patent No. 5,378,619 and will continue to do so unless enjoined by this court.

65. Defendant's infringement of U.S. Patent No. 5,378,619, upon information and belief, is knowing and willful.

**COUNT III- TRADE SECRET MISAPPROPRIATION**

66. Monsanto re-alleges and incorporates by reference each of paragraphs 1-65 above as set forth herein.

67. Pursuant to the 1992 License Agreement and the 1998 Canola/Rapeseed License Agreement, Monsanto supplied Pioneer with confidential and proprietary information belonging to Monsanto. That information was subject to obligations of confidentiality pursuant to the 1992 License Agreement and the 1998 Canola/Rapeseed License

68. On information and belief, Pioneer has transferred that information to du Pont Sub, the new corporate entity created by E.I. du Pont de Nemours and Company, in violation of the 1992 License Agreement and the 1998 Canola/Rapeseed License Agreement. Further, on information

and belief, Defendant is misappropriating and using Monsanto's confidential information without any authorization from Monsanto to the detriment of Monsanto.

**Jury Demand**

69. Plaintiff requests a trial by jury for every issue so triable as of right.

**Prayer for Relief**

WHEREBY PLAINTIFF MONSANTO PRAYS FOR THE FOLLOWING RELIEF:

(a) Entry of Judgment that: (1) Defendant has breached the 1992 License Agreement by virtue of the purported transfer to du Pont Sub, a new corporate entity created by E.I. du Pont de Nemours and Company, and that the 1992 License Agreement is terminated as to Pioneer as it no longer exists and that du Pont Sub is without any rights under such 1992 Agreement; and (2) the Trademark License Agreement, which is a part of the 1992 License Agreement, is terminated and du Pont Sub is without authority to use the Roundup Ready® trademark in connection with sale or offer for sale of soybeans or varietal rapeseed and that any such use will constitute trademark infringement;

(b) Entry of Judgment that: (1) Defendant has breached the 1998 Canola/Rapeseed License Agreement by virtue of the purported transfer to du Pont Sub, a new corporate entity created by E.I. du Pont de Nemours and Company, and that the 1998 Canola/Rapeseed License Agreement is terminated as to Pioneer as it no longer exists and that du Pont Sub is without any rights under such 1998 Agreement; and (2) the Trademark License Agreement, which is a part of the 1998 Canola/Rapeseed License Agreement, is terminated and du Pont Sub is without authority to use the Roundup Ready® trademark in connection with sale or offer for sale of soybeans or varietal rapeseed and that any such use will constitute trademark infringement;

(c) Entry of an order requiring return or destruction the of the GENE and all other Monsanto KNOW-HOW or other confidential information of Monsanto, including all germplasm containing Monsanto's CP4 gene and GOX gene;

(d) Entry of an order preliminarily and permanently enjoining Defendant, and its officers, agents, servants, employees, subsidiaries, affiliates, attorneys and those persons in active concert or participation with them who receive actual notice thereof, from further misappropriation or use of Monsanto KNOW-HOW and confidential information;

(e) Entry of an order preliminarily and permanently enjoining Defendant, and its officers, agents, servants, employees, subsidiaries, affiliates, attorneys and those persons in active concert or participation with them, from infringing U.S. Patent No. 5,633,435; 4,940,835; 5,188,642; 5,352,605; 5,530,196; 5,776,760; and 5,378,619.

(f) Entry of an order determining that this is an exceptional case under 35 U.S.C. § 285 and awarding Monsanto its attorneys' fees, costs and expenses in this action in light of Defendant's willful acts; and

(g) Such further relief as the Court may deem appropriate, appropriate including an accounting and all damages arising from the aforesaid acts including trebling of damages as may be trebled, and an award of prejudgment interest.

Respectfully submitted,

HUSCH & EPPENBERGER, LLC

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UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF MISSOURI  
EASTERN DIVISION

MONSANTO COMPANY, )  
Plaintiff, )  
v. ) Case No. 4:99 CV 1917 DJS  
PIONEER HI-BRED INTERNATIONAL, )  
INC., )  
Defendant. )

**DEFENDANT PIONEER'S FIRST ANSWER TO  
PLAINTIFF MONSANTO'S COMPLAINT**

Defendant Pioneer Hi-Bred International, Inc. ("Pioneer") files this First Answer to Plaintiff Monsanto Company's ("Monsanto's") Complaint, filed December 8, 1999, and answers as follows below. To the extent not specifically admitted herein, all allegations of the Complaint are denied.

1. Pioneer admits the allegations in paragraph 1 of Monsanto's complaint to the extent consistent with the Court's case management order dated July 3, 2000, bifurcating Monsanto's claims in this action.

**The Parties**

2. Pioneer admits the allegations contained in paragraph 2.

3. Pioneer admits the allegations contained in the first sentence of paragraph three that Pioneer, prior to October 1, 1999, was a corporation named Pioneer Hi-Bred International, Inc., organized under the laws of the State of Iowa with its principal place of business located at 700 Capital Square, 400 Locust Street, Des Moines, Iowa, but denies

those allegations to the extent that they allege that Pioneer ceased on October 1, 1999, to be a corporation organized under the laws of the State of Iowa with its principal place of business located at 700 Capital Square, 400 Locust Street, Des Moines, Iowa. Pioneer denies any remaining allegations in paragraph 3.

4. Pioneer admits that on October 1, 1999, Pioneer merged into Delta Acquisition Sub, Inc., a wholly-owned subsidiary of E.I. du Pont de Nemours and Company, Inc., created solely for purposes of effectuating the merger, and otherwise denies the remaining allegations in paragraph 4.

5. Pioneer admits the allegations in paragraph 5, to the extent consistent with its response to paragraphs 3 and 4 above.

6. Pioneer admits the allegations in paragraph 6, to the extent consistent with its response to paragraphs 3 and 4 above.

7. Pioneer avers that the allegations in paragraph 7 call for a legal conclusion and otherwise denies those allegations.

8. Paragraph 8 does not appear to contain any allegations to which a response is required, but to the extent a response is required, Pioneer denies those allegations.

#### **Jurisdiction and Venue**

9. Pioneer admits the allegations in paragraph 9.

10. For purposes of answering Count I of Monsanto's Complaint, Pioneer admits the allegation in paragraph 10 that subject matter jurisdiction is conferred on this Court by 28 U.S.C. § 1332, and therefore no response is needed to the remainder of paragraph 10.

11. For purposes of answering Count I of Monsanto's Complaint, Pioneer admits the allegation in paragraph 11 that venue is permissible under 28 U.S.C. § 1391, and therefore no response is needed to the remainder of paragraph 11.

### **Background**

12. On information and belief, Pioneer admits the allegations in paragraph 12.

13. Pioneer admits that it entered into the 1992 and 1998 License Agreements with Monsanto, avers that the 1992 and 1998 License Agreements speak for themselves, and otherwise denies the allegations in paragraph 13.

14. Pioneer avers that the 1992 License Agreement speaks for itself and otherwise denies the allegations in paragraph 14.

15. Pioneer avers that the 1992 License Agreement speaks for itself and otherwise denies the allegations in paragraph 15.

16. Pioneer avers that the 1992 License Agreement speaks for itself and otherwise denies the allegations in paragraph 16.

17. Pioneer avers that the 1992 License Agreement speaks for itself and otherwise denies the allegations in paragraph 17.

18. Pioneer avers that the 1992 License Agreement speaks for itself and otherwise denies the allegations in the first sentence of paragraph 18. Pioneer admits that Monsanto crossed or attempted to cross germplasm from a Monsanto soybean event designated 40-3-2 into Pioneer germplasm and delivered some germplasm to Pioneer, and otherwise denies the allegations in the second sentence. Pioneer denies the allegations in the third sentence.

19. Pioneer avers that the 1998 License Agreement speaks for itself and otherwise denies the allegations in paragraph 19.

20. Pioneer avers that the 1998 License Agreement speaks for itself and otherwise denies the allegations in paragraph 20.

21. Pioneer avers that the 1998 License Agreement speaks for itself and otherwise denies the allegations in paragraph 21.

22. Pioneer reserves its response to the allegations in paragraph 22 until such time as the patent issues are under litigated the Court's case management order bifurcating the claims in this action, and to the extent necessary at present denies those allegations.

23. Pioneer reserves its response to the allegations in paragraph 23 until such time as the patent issues are under litigated the Court's case management order bifurcating the claims in this action, and to the extent necessary at present denies those allegations.

**Alleged Breach and Termination of the 1992 License Agreement**

24. Pioneer avers that the 1992 License Agreement speaks for itself and otherwise denies the allegations in paragraph 24.

25. Pioneer avers that the 1992 License Agreement speaks for itself and otherwise denies the allegations in paragraph 25.

26. Pioneer admits that it continues to produce, sell and offer for sale soybeans containing genetic material acquired pursuant to and consistent with the terms of the 1992 License Agreement, which speaks for itself, and Pioneer denies the remaining allegations in paragraph 26.

**Alleged Breach and Termination of the 1998 License Agreement**

27. Pioneer avers that the 1998 License Agreement speaks for itself and otherwise denies the allegations in paragraph 27.

28. Pioneer avers that the 1998 License Agreement speaks for itself and otherwise denies the allegations in paragraph 28.

29. Pioneer admits that it continues to produce, sell and offer for sale rapeseed containing genetic material acquired pursuant to and consistent with the terms of the 1998 License Agreement, which speaks for itself, and Pioneer denies the remaining allegations in paragraph 29.

#### **Count I – Breach of Contract**

30. Pioneer re-alleges and incorporates by reference its responses to paragraphs 1 through 29 as set forth herein, and denies any remaining allegations in paragraph 30.

31. Pioneer denies the allegations in paragraph 31.

32. Pioneer avers that sections 10.3 and 11.2 of the 1992 License Agreement speak for themselves. Pioneer denies that it has breached the 1992 License Agreement, that the 1992 License Agreement has terminated, that paragraph 32 is or could be proper notice of termination, and/or that Monsanto can avail itself of the remedies described in sections 10.3 and 11.2 of the 1992 License Agreement. Pioneer denies all other allegations in paragraph 32.

33. Pioneer denies the allegations in paragraph 33.

34. Pioneer re-alleges and incorporates by reference its responses to paragraphs 1 through 33 as set forth herein, and denies any remaining allegations.

35. Pioneer denies the allegations in paragraph 35.

36. Pioneer denies the allegation in paragraph 36 that Monsanto can give notice of termination under Section 10.4 of the 1998 License Agreement, and avers that sections 10.3, 10.4, and 11.2 of the 1998 License Agreement speak for themselves. Pioneer denies that it

has breached the 1998 License Agreement, that the 1998 License Agreement has terminated, that paragraph 36 is or could be proper notice of termination, and/or that Monsanto can avail itself of the remedies described in sections 10.3, 10.4, and 11.2 of the 1998 License Agreement. Pioneer denies all other allegations in paragraph 36.

37. Pioneer denies the allegations in paragraph 37.

As to paragraphs 38 to 68 of Monsanto's Complaint, Pioneer denies Monsanto's allegations of patent infringement and trade secret misappropriation as contained therein and reserves a more specific answer to those allegations, including any affirmative defenses and counterclaims thereto, until if and when the patent issues are litigated under the Court's case management order bifurcating the claims in this action.

Pioneer requests a trial by jury for every issue so triable as of right.

As to Monsanto's prayer for relief, Pioneer denies that Monsanto is entitled to any of the relief requested, or any other relief.

#### **Affirmative Defenses To Monsanto's Breach Of Contract Claim**

1. Monsanto's breach of contract claim fails to state facts sufficient to constitute a cause of action against Pioneer.
2. Monsanto's breach of contract claim against Pioneer is barred by waiver and/or estoppel.
3. Monsanto's breach of contract claim against Pioneer is barred by laches.
4. Monsanto's breach of contract claim against Pioneer is barred because Pioneer has performed its obligations required under the 1992 and 1998 License Agreements.
5. Monsanto's breach of contract claim against Pioneer and the relief requested by Monsanto against Pioneer is barred because Monsanto is guilty of unclean hands.

6. Monsanto's breach of contract claim against Pioneer and the relief requested by Monsanto against Pioneer is barred because Monsanto has failed to make reasonable efforts to mitigate or minimize any damages or other harm resulting from Pioneer's alleged breaches.

7. Monsanto's breach of contract claim against Pioneer and the relief requested by Monsanto against Pioneer is barred because Monsanto failed to comply with the notice provisions for termination of the 1992 and/or the 1998 License Agreements.

**LEWIS, RICE AND FINGERSH, L.C.**

Dated: July 7, 2000

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**CERTIFICATE OF SERVICE**

The undersigned certifies that a true and correct copy of the foregoing was either hand delivered or sent via express mail, as indicated below, the 7<sup>th</sup> day of July, 2000.

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